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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,071	09/04/2001	Masanobu Asaoka	35.C15758	1151
5514	7590	05/17/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SCHWARTZ, PAMELA R	
			ART UNIT	PAPER NUMBER
			1774	
DATE MAILED: 05/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,071

Applicant(s)

ASAOKA ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 17-23 is/are pending in the application.
4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 13, 15 and 17-23 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 1-13, 15 and 17-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/28/05
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

1. Claims 13, 15, 17-18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asano et al. (6,511,736) in view of any of JP 10129112, Darsillo et al (WO 01/25534), and Hirose et al. (EP 0,732,219) for reasons of record and for reasons given below.
2. Claims 13 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asano et al. (6,511,736) in view of any of JP 10129112, Darsillo et al (WO 01/25534), and Hirose et al. (EP 0,732,219) as applied to claim 13 above, and further in view of either one of Hosoi et al. (6,200,670) or Ikezawa et al. (5,759,673) for reasons of record and for reasons given below.
3. Claims 13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asano et al. (6,511,736) in view of any of JP 10129112, Darsillo et al (WO 01/25534), and Hirose et al. (EP 0,732,219) as applied to claim 13 above, and further in view of Tomizawa et al. (5,985,425) for reasons of record and for reasons given below.
4. Applicant's arguments with respect to claims 1-13, 15 and 17-23 have been fully considered but are not persuasive. The applicable disclosures and teachings of the references are not limited to the examples. Therefore, reliance on the disclosure of a sizing degree of 200 sec in the primary reference is appropriate. In addition, it is proper to look to secondary art for the properties of an aluminum oxide appropriate for inclusion as the alumina of Asano et al.

Applicants' argument that "even if the surface layer is cast-treated with the re-wet cast method, the high gloss of the present invention cannot be obtained." This is not persuasive. Applicants' argue that in the cast method, as used in the reference

examples, a low sizing degree is needed so that moisture can escape through the back of the paper. While the examples of Asano et al. are to the cast method and therefore require the low sizing degree, this would not suggest to one of ordinary skill in the art that a low sizing degree be used with the re-wet method, also disclosed by the reference. It would have been obvious to one of ordinary skill in the art to increase the degree of sizing as disclosed in the reference when utilizing a method that did not require moisture to escape through the paper.

That Asano et al. disclose both alumina and silica is not relevant to patentability in the absence of a showing to distinguish the inclusion of alumina from the inclusion of silica. With respect to gloss, the teaching of measuring gloss is sufficient to suggest to one of ordinary skill in the art that gloss is an important property of the medium that should be controlled. It would have been obvious to one of ordinary skill in the art to measure the gloss in a manner and at an angle most relevant to the intended use of the medium. Finally, it is noted that it is the combination of references rather than a single reference that is relied upon for teaching the inclusion of crystalline aluminum oxide in the re-wet cast treatment method.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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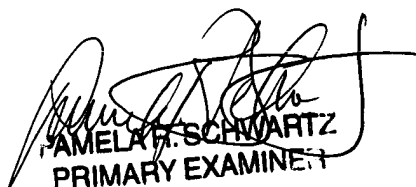
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
May 6, 2005



PAMELA H. SCHWARTZ
PRIMARY EXAMINER